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December 4, 2003

GROUP: 1635

FAX NUMBER: 1-703-872-9306

ATTORNEY DOCKET NO.: ISPH-0623

SERIAL NO.: 10/033,742

FILED: December 28, 2001

NUMBER OF PAGES: 11
(including this sheet)

MESSAGE: Attached is an Amendment Transmittal Letter (in duplicate);
Amendment in Response to Office Communication dated November 7, 2003 and
a Notification of a Change of Status to Large Entity.

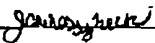
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AMENDMENT TRANSMITTAL LETTER (Large Entity)				Docket No. ISPH-0623	
Applicant(s): Karras and Condon					
Serial No. 10/033,742	Filing Date December 28, 2001	Examiner Terra C. Gibbs		Group Art Unit 1635	
Invention: ANTISENSE MODULATION OF MACROPHAGE INFLAMMATORY PROTEIN 3-ALPHA EXPRESSION					
<u>TO THE COMMISSIONER FOR PATENTS:</u>					
Transmitted herewith is an amendment in the above-identified application. The fee has been calculated and is transmitted as shown below.					
CLAIMS AS AMENDED					
	CLAIMS REMAINING AFTER AMENDMENT	HIGHEST # PREV. PAID FOR	NUMBER EXTRA CLAIMS PRESENT	RATE	ADDITIONAL FEE
TOTAL CLAIMS	12 -	20 -	0 x	\$18.00	\$0.00
INDEP. CLAIMS	1 -	3 -	0 x	\$86.00	\$0.00
Multiple Dependent Claims (check if applicable) <input type="checkbox"/>					\$0.00
TOTAL ADDITIONAL FEE FOR THIS AMENDMENT					\$0.00
<div style="margin-top: 20px;"><input type="checkbox"/> No additional fee is required for amendment. <input type="checkbox"/> Please charge Deposit Account No. _____ in the amount of _____ <input type="checkbox"/> A check in the amount of _____ to cover the filing fee is enclosed. <input checked="" type="checkbox"/> The Director is hereby authorized to charge payment of the following fees associated with this communication or credit any overpayment to Deposit Account No. 50-1619 <input checked="" type="checkbox"/> Any additional filing fees required under 37 C.F.R. 1.16. <input checked="" type="checkbox"/> Any patent application processing fees under 37 CFR 1.17.</div>					
<div style="text-align: center;"> _____ Signature</div> <div>Jane Massey Licata Reg. No. 32,257 Licata & Tyrrell P.C. 66 E. Main Street Marlton, NJ 08053 Tel: 856-810-1515 Fax: 856-810-1454</div>			Dated: December 4, 2003		
CC:			<div>I certify that this document and fee is being deposited on _____ with the U.S. Postal Service as first class mail under 37 C.F.R. 1.8 and is addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.</div> <div style="text-align: center; margin-top: 10px;">_____ Signature of Person Mailing Correspondence</div> <div style="text-align: center; margin-top: 10px;">_____ Typed or Printed Name of Person Mailing Correspondence</div>		

CERTIFICATE OF TRANSMISSION BY FACSIMILE (37 CFR 1.8)			Docket No.
Applicant(s): <i>Karras and Condon</i>			ISPH-0623
Serial No. 10/033,742	Filing Date December 28, 2001	Examiner Terra C. Gibbs	Group Art Unit 1635
Invention: ANTISENSE MODULATION OF MACROPHAGE INFLAMMATORY PROTEIN 3-ALPHA EXPRESSION			
<p>I hereby certify that this _____ <u>Reply under 37 C.F.R. 1.111</u> _____ (Identify type of correspondence)</p> <p>is being facsimile transmitted to the United States Patent and Trademark Office (Fax. No. <u>703-382-9306</u>)</p> <p>on <u>December 4, 2003</u> (Date)</p> <p style="text-align: right;">_____ Jane Massey Licata (Typed or Printed Name of Person Signing Certificate)</p> <p style="text-align: right;">_____ <i>Jane Massey Licata</i> (Signature)</p> <p style="text-align: center;">Note: Each paper must have its own certificate of mailing.</p>			

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Attorney Docket No.: ISPH-0623
Inventors: Karras and Condon
Serial No.: 10/033,742
Filing Date: December 28, 2001
Examiner: Terra C. Gibbs
Group Art Unit: 1635
Title: Antisense Modulation of Macrophage
Inflammatory Protein 3-Alpha Expression

Certificate of Facsimile Transmission

I hereby certify that this paper is being facsimile
transmitted to the Patent and Trademark Office on
the date shown below.

On December 4, 2003

Jane Massey
Jane Massey Licata Registration No. 32,257

Assistant Commissioner for Patents
Washington, DC 20231

Reply under 37 C.F.R. § 1.111

This is a reply to the Office Communication mailed November 7,
2003 setting a one (1) month statutory period for response. Please
enter the following remarks into the record. No new matter has been
added by this response.

Remarks begin on page 2 of this paper.

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Inventors: Karras and Condon
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REMARKS

The Examiner indicates that claims 1-2, 4-10, 12, and 13 are pending in the instant application. No new matter has been added by these amendments. Reconsideration is respectfully requested in light of these amendments and the following remarks.

Claim 1 recites a compound 8 to 50 nucleobases in length targeted to a 5'-untranslated region, a start codon region, a coding region, or a 3'-untranslated region of a nucleic acid molecule encoding macrophage inflammatory protein 3-alpha (SEQ ID NO: 3), wherein said antisense oligonucleotide specifically hybridizes with one of said regions and inhibits the expression of macrophage inflammatory protein 3-alpha of SEQ ID NO:3, these sequences are considered to be unrelated. Each sequence encompassed by claim 1 is suggested to be structurally and functionally independent and distinct. The Examiner suggests that each sequence has a unique nucleotide sequence, it is further suggested that each sequence targets a different and specific region of the molecule encoding macrophage inflammatory protein 3-alpha.

The Examiner further suggests that a search of more than one of the claimed sequences presents an undue burden on the Patent and Trademark Office because of the complex nature of the search required and because a search for art related to one region of the

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macrophage inflammatory protein 3-alpha would not reveal art related to another region. The Examiner requires that Applicants elect one target region from claim 1.

Applicants respectfully traverse this restriction requirement.

MPEP 803 states that an application may properly be required to be restricted to one of two or more claimed inventions only if they are able to support separate patents and they are either independent or distinct. MPEP 803 further states that if the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.

MPEP 802.1 defines "independent" as having no disclosed relationship between the two or more subjects disclosed, that is, they are unconnected in design, operation, or effect, for example: (1) species under a genus which species are not usable together as disclosed; or (2) process and an apparatus incapable of being used in practicing the process.

MPEP 802.1 defines "distinct" as two or more subjects as disclosed are related, for example, as combination and part (subcombination) thereof, process and apparatus for its practice, process and product made, etc., but are capable of separate

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manufacture, use, or sale as claimed, and are patentable over each other.

Additionally, it has been determined that normally ten sequences are deemed to constitute a reasonable number for examination purposes. Accordingly, in most cases, up to ten independent and distinct nucleotide sequences can be examined in a single application without restriction.

By definition, the sequences cannot be independent because they all target and modulate the same single sequence, namely SEQ ID NO:3. Therefore, there is a disclosed and acknowledged relationship between the sequences.

There would be no additional search burden on the Examiner because any search relating to macrophage inflammatory protein 3-alpha (SEQ ID NO:3) would necessarily identify all of the art relating to all of the sequences recited in claim 1.

Applicants respectfully request reconsideration and withdrawal of the restriction requirement.

However, in an earnest effort to facilitate prosecution, Applicants elect a compound 8 to 50 nucleobases in length targeted to a 3'-untranslated region of a nucleic acid molecule encoding macrophage inflammatory protein 3-alpha (SEQ ID NO: 3), wherein

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said compound specifically hybridizes with said region and inhibits the expression of macrophage inflammatory protein 3-alpha.

Applicants believe that the foregoing comprises a full and complete response to the Office Action of record. Accordingly, favorable reconsideration and subsequent allowance of the pending claims is earnestly solicited.

Respectfully submitted,

Jane Massey Licata

Jane Massey Licata
Registration No. 32,257

Date: December 4, 2003

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